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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/884,778	06/30/97	NAKAMURA K	80A2601-CIP

IM51/0922

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EXAMINER	
MARCHESCHI,M	
ART UNIT	**PAPER NUMBER**
1755	

DATE MAILED: 09/22/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/884,778	Applicant(s) Nakamura
	Examiner Michael Marcheschi	Group Art Unit 1755

☒ Responsive to communication(s) filed on *Aug 12, 1998* .

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1 and 2* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1 and 2* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

For the residence, the declaration sets forth "CA" for the state or country, which is clearly not the case. This should be "Japan".

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokiwa et al. alone or in view of Moriya et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 8/12/98 have been fully considered but they are not persuasive.

Applicant argues that the claimed invention is not disclosed by Tokiwa et al. because volume and weight percentages are quite different measures. The examiner realizes that the percentages are measured differently, but as is readily apparent (inferred) from the last office action (although not set forth), it is the examiners position that when the amounts defined by the reference are converted to weight percent, they will encompass the claimed range in the absence of any evidence showing the contrary. Applicant also argues that although the natural high molecular weight substance according to Tokiwa et al. do include pulp powder or powdery

cellulose, neither term is defined and therefore is not within the scope of the instant claims. Applicant also argues that the term "powdery cellulose" is not paper powder. Although the reference might not literally set forth what the powdery cellulose is or even mention paper, it is the examiners position that the **broad interpretation** of this substance can include powdery paper. The reasoning behind the above statement is that paper is a cellulose substance and therefore by inference, powdery cellulose can imply powdery paper. Since applicant has not provided any evidence to refute the examiners position, no distinction is seen to exist. In addition, it is the examiners position that the **broad interpretation** of pulp powder encompasses paper pulp powder since paper pulp is a well known pulp material in the absence of any evidence showing the contrary.

Applicant argues Moriya et al. because it is directed to catalysts and teaches crystalline cellulose which is unlike ordinary paper. The examiner acknowledges this, but has applied this reference only to teach that (1) paper is a well known source of cellulose, irrespective of what kind of paper it is and (2) that pulverizing paper is a well known way to make a powder.

Finally, applicant has not argued the combination as applied in the above rejection (no argument based on the combination as applied) and therefore no patentable distinction is seen to exist. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In view of the teachings as set forth above, it is still the examiners position that the references reasonably teach or suggest the limitations of all the claims.

"A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Marcheschi whose telephone number is (703) 308-3815. The examiner can be normally be reached on Monday through Thursday between the hours of 8:30-6:00 and every other Friday between the hours of 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Mark L. Bell, can be reached at (703) 308-3823.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Michael Marcheschi
Art unit 1755
9/21/98

MICHAEL MARCHESCHI
PRIMARY EXAMINER